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09/910,316	07/19/2001	Daniel Putterman	MEDB.P0001	2016
23349 7590 04/13/2007 STATTLER JOHANSEN & ADELI LLP 60 SOUTH MARKET SUITE 480 SAN JOSE, CA 95113			EXAMINER SALCE, JASON P	
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SHORTENED STATUTORY PERIOD OF RESPONSE			MAIL DATE	DELIVERY MODE
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Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/910,316

Applicant(s)

PUTTERMAN ET AL.

Examiner

Jason P. Salce

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 February 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 85-93 and 101-111 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 85-93 and 101-111 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. In response to the Pre-Appeal Conference request filed 12/19/2006, prosecution has been reopened and a new grounds of rejection has been entered.

In regards to Applicant's arguments in the Pre-Appeal Brief, a new grounds of rejection under 102(e) in view of Elliot et al. (U.S. Patent No. 6,751,402). Furthermore the 112 1st Paragraph rejection stands and the arguments regarding this rejection made in the Pre-Appeal Conference request are addressed below.

Regarding the 112 1st Paragraph rejection of claim 101, Applicant states Paragraph 0038 states that the set top box 230 (control/playback box) may be incorporated into set-top box 220. The examiner fails to see how the integrated functionality of the two set top boxes relates to running at least one of a plurality of media applications on a client device based on said type of digital data content object. Regardless of the integrated functionality of these two set top boxes, the specification still fails to teach that even one of these set top boxes runs one of a plurality of media applications based on said type of digital data content object. The examiner agrees that the specification teaches that the set top boxes are capable of playing different types of digital content objects, but the specification fails to teach how one of a plurality of media applications (shown in Figure 7) achieves such result. Furthermore, the specification does not teach that the media control module is used for running at least one of a plurality of media applications on a client device. The examiner notes that the client device is simply a display device (see Figure 2) and that according to the specification,

the set top box contains the applications to retrieve, store and output a digital content object for display on the client device, not the client device.

Applicant further argues that Paragraph 0052 states that set top box 220 also includes a media playback module 420 and a media control module 450. Again, the examiner does not understand how merely stating that a set top box contains two different media applications provides support for the media control module being used for running at least one of a plurality of media applications **on a client device based on said type of digital data content object.**

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claim 101 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Applicant has amended the claims to recite that the control and acquisition set-top box runs, "*at least one of a plurality of media applications on a client device on said type of digital data content object*". The examiner notes that on Paragraphs 0033-0037 and 0040-0041, the specification states that the acquisition set top box 220 only

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acquires content objects from multiple devices attached to the bus 200 and does not teach running a media application on one of the attached client devices.

Regarding the 112 1st Paragraph rejection of claim 101, Applicant states Paragraph 0038 states that the set top box 230 (control/playback box) may be incorporated into set-top box 220. The examiner fails to see how the integrated functionality of the two set top boxes relates to running at least one of a plurality of media applications on a client device based on said type of digital data content object. Regardless of the integrated functionality of these two set top boxes, the specification still fails to teach that even one of these set top boxes runs one of a plurality of media applications based on said type of digital data content object. The examiner agrees that the specification teaches that the set top boxes are capable of playing different types of digital content objects, but the specification fails to teach how one of a plurality of media applications (shown in Figure 7) achieves such result. Furthermore, the specification does not teach that the media control module is used for running at least one of a plurality of media applications on a client device. The examiner notes that the client device is simply a display device (see Figure 2) and that according to the specification, the set top box contains the applications to retrieve, store and output a digital content object for display on the client device, not the client device. The examiner further notes although the specification teaches that both set-top boxes can be integrated, the specification fails to teach how such an integration could be used in a way that would support the claim limitations.

Applicant further argues that Paragraph 0052 states that set top box 220 also includes a media playback module 420 and a media control module 450. Again, the examiner does not understand how merely stating that a set top box contains two different media applications provides support for the media control module being used for running at least one of a plurality of media applications **on a client device based on said type of digital data content object.**

Although the specification fails to teach this limitation, the examiner notes that it is well known in the art for client device applications to be controlled by a master device in a home network, by the use of API or any other type of software level interface for devices (for example Sony's HAVI home network systems), which can contain various types of applications and protocols that are used to decode different types of digital content objects (photos, video, audio) for display on a display device. Therefore, in order to expedite the prosecution of the instant application, the examiner will reject the claims as written and will take Official Notice to the fact of "*running at least one of a plurality of media applications on a client device on said type of digital data content object*" (see rejection below).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the

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applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 85-88, 106 and 108-111 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Elliot et al. (U.S. Patent No. 6,751,402).

Referring to claim 85, Elliot discloses a home media system (see Figure 2) comprising a network (see Column 5, Lines 51-58).

Elliot also discloses that the home media system further comprises an acquisition storage set-top box (see personal video recorder 200 in Figure 2), coupled to said network (see Column 5, Lines 56-58), for storing at least one digital data content object (see stored video streams 222 and 223 in Figure 3).

Elliot also discloses that the control/playback set-top box (see set-top box 100 in Figure 2), coupled to said network (see Column 5, Lines 51-56 and note that auxiliary interface 130 is a component of set top box 100 in Figure 2), comprising a media playback module (see video output interface 120 in Figure 2) and a media control module (see microprocessor 140 in Figure 2), said media control module comprising an applications module for accessing, across said network, at least one digital data content object from said acquisition storage set-top box (see Column 3, Lines 20-24 and Column 6, Lines 36-53 for a microprocessor (media control module) that recognizes the connection to the digital video recorder 200 and in response to user input 142, generates the command that initiates the playback of a recorded television program stored on the digital video recorder 200), and for running at least one media application that provides functionality, through a user interface, to play media (see Column 4, Lines

19-47 for providing a media application to play media in the form of an electronic program guide), said media playback module comprising a decoder for decoding media comprised in said digital data content object (see video output interface 120 containing MPEG decoder 122 in Figure 2 and Column 5, Lines 16-39).

Elliot also discloses a client device (see display device 300 in Figure 2), coupled to said control/playback set top box (see Figure 2 for display device 300 coupled to set top box 100 in Figure 2), for displaying said user interface for said media application (see Column 4, Lines 37-40) and for playing media comprised in said digital data content object (see Column 3, Line 64 through Column 4, Line 2).

Referring to claim 86, Elliot discloses that said acquisition set top box further acquires said digital data content object external to said network (see Column 3, Lines 1-61 for receiving a broadcast signal 102 to set top box 100 and providing the broadcast signal to the disk 220 in the digital video recorder 200 for storage, therefore, since the stored video stream is received from a broadcast source (which is external to said home network shown in Figure 2), the digital video recorder (acquisition set top box) 200 clearly receives said digital data content object external to said network).

Referring to claim 87, Elliot discloses that said decoder comprises an MPEG decoder (see MPEG decoder 122 in Figure 2).

Referring to claim 88, Elliot discloses that the control/playback set top box comprises a microprocessor, auxiliary interface that comprises an IEEE 1394 circuitry (see rejection of claim 85) and receives user input to allow a user to control the device, as well as outputting an EPG and video output to an external display (see Figure 2), therefore the control/playback set top box clearly represents a personal computing device.

Referring to claim 106, see the rejection of claim 85 and further note that Elliot also discloses running at least one of a plurality of media applications suitable for said type of digital data content object (see Column 3, Line 66 through Column 4, Line 2 for the microprocessor 140 determining whether to provide a video stream broadcasted over broadcast transmission path 102 or a video stream from the digital video recorder 200 in Figure 2, which are two different types of digital data content objects).

Referring to claims 108-109, see the rejection of claims 104-105, respectively.

Referring to claims 110-111, see the rejection of claims 86 and 88, respectively.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 89 is rejected under 35 U.S.C. 103(a) as being unpatentable over Elliot et al. (U.S. Patent No. 6,751,402) in view of Zhou (U.S. Patent No. 6,353,700).

Referring to claim 89, Elliot discloses all of the limitations in claim 85, but is silent about the control/playback set-top box comprises a frame buffer.

Zhou discloses the use of frame buffers 402, 404 and 406 in Figure 4 for storing MPEG decoded frames, decoded by an MPEG decoder (see Column 6, Lines 51 through Column 7, Line 32).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art, to modify the video output interface 120, as taught by Elliot, to utilize the frame buffers, as taught by Zhou, for the purpose of providing a method and apparatus for playing an MPEG data file backward with a linear speed and even decoding computation for each of the compressed frames (see Column 2, Lines 51-54 of Zhou).

5. Claims 90, 103 and 107 are rejected under 35 U.S.C. 103(a) as being unpatentable over Elliot et al. (U.S. Patent No. 6,751,402) in view of Dara-Abrams et al. (U.S. Patent No. 6,826, 512).

Referring to claim 90, Elliot discloses all of the limitations of claim 85, but fails to teach that the home media system further comprises a PDA for receiving user input to control said control/playback set-top box.

Dara-Abrams discloses a gateway device 14, which can be a PDA (see Column 3, Lines 53-56) in a home media system (see Figure 2), which controls audio/video

content to be transferred between multiple electronic devices 30, which includes a control/playback set-top box (see set-top box 58 in Figure 2).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art, to modify the home media system, as taught by Elliot, to utilize the PDA/gateway device, as taught by Dara-Abrams, for the purpose of providing a diversity of additional different consumer electronic devices commonly found in the average home (see Column 1, Lines 15-16 of Dara-Abrams).

Referring to claim 103, Elliot discloses all of the limitations in claims 85, but fails to teach that said media application comprises a photo application for viewing digital data content objects comprising digital photo files.

Dara-Abrams discloses the use of a digital camera in a home network system to provide digital photo content objects (see Column 6, Lines 30-34).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art, to modify the home media system, as taught by Elliot, to utilize the digital camera to provide photo content objects, as taught by Dara-Abrams, for the purpose of providing a diversity of additional different consumer electronic devices commonly found in the average home (see Column 1, Lines 15-16 of Dara-Abrams).

Referring to claim 107, see the rejection of claim 103.

6. Claim 91 is rejected under 35 U.S.C. 103(a) as being unpatentable over Elliot et al. (U.S. Patent No. 6,751,402) in view of Mano et al. (U.S. Patent No. 5,793,366).

Referring to claim 91, Elliot discloses all of the limitations of claim 85, but fails to teach a personal computer for organizing a plurality of digital data content objects stored on said acquisition storage set-top box.

Mano discloses that a personal computer can be used in an IEEE 1394 home network system, similar to Iwamura (see computer 18 in Figure 1). The personal computer 18 controls the OSD/GUI (graphical user interface 10), which allows a user to playback media from other digital devices (see Column 4, Lines 35-56). Further note that Mano discloses that the personal computer organizes a plurality of digital data content objects stored on said acquisition storage set-top box (see Figures 1 and 3 and Column 7, Lines 15-34 for the personal computer generating a GUI, which can access and organize/edit the data stored on a DVCR 30 or the digital camcorder 40).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art, to modify the control/playback set-top box, as taught by Elliot, using the personal computer, as taught by Mano, for the purpose of providing a control device and interface that allows the user to control a variety of devices from a common source using a common control interface (see Column 2, Lines 50-52 of Mano).

7. Claim 92 is rejected under 35 U.S.C. 103(a) as being unpatentable over Elliot et al. (U.S. Patent No. 6,751,402) in view of Humpleman et al. (U.S. Patent No. 6,182,094).

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Referring to claim 92, Elliot discloses all of the limitations in claim 85, but fails to teach that the control/playback set-top box identifies said user and restricts access to digital content objects based on said user.

Humpleman discloses identifying a user and restricting access to digital data content objects based on said user (see Column 20, Lines 52-56)..

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art, to modify the home network IRD 100, as taught by Elliot, to include the security mechanism, taught by Humpleman, for the purpose of avoiding potential security access issues (see Column 20, Lines 52-53 of Humpleman).

8. Claim 93 is rejected under 35 U.S.C. 103(a) as being unpatentable over Elliot et al. (U.S. Patent No. 6,751,402) in view of Iwamura et al. (U.S. Patent No. 5,883,621).

Referring to claim 93, Elliot discloses all of the limitations in claim 85, but fails to teach a digital device for accessing digital data stored on a digital medium and a device interface, coupled to said digital device, for decoding said digital data and for transmitting said digital data on said network.

Iwamura discloses that the home media system further comprises a digital device (see MD recorder 110, DVD Player 106 or DVCR2 112 in Figure 1) for accessing digital data stored on a digital medium (note that any of the digital devices mentioned above acquires digital data from a digital medium, such as a DVD, MD or storage device accessed by DVCR2) and a device interface, coupled to said digital device, for decoding said digital data (note that any of the digital devices mentioned above contain

circuitry that decodes the data on the digital medium in order for proper transmission over a 1394 network cable) and for transmitting said digital data on said network (note that of the devices contain IEEE 1394 bus interfaces used to transmit the digital data content objects over the 1394 network cables). Further note Figure 12, for transferring digital data from a DVD 900 to a DVCR1 903.

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art, to modify the home network system, as taught by Elliot, using the DVD player transferring digital data (over an IEEE 1394 network) to a DVCR1, as taught by Iwamura, for the purpose of allowing multiple devices in a home network to be controlled and displayed using a topology map displayed as part of a graphical user interface (see Column 1, Lines 5-8 of Iwamura).

9. Claims 101-102 and 104-105 are rejected under 35 U.S.C. 103(a) as being unpatentable over Elliot et al. (U.S. Patent No. 6,751,402).

Referring to claim 101, Elliot discloses a home media system (see Figure 2) comprising a network (see Column 5, Lines 51-58).

Elliot also discloses a control and acquisition set-top box (see digital video recorder 200 in Figure 2), coupled to said network (see Column 5, Lines 51-58), for storing a plurality of different types of digital data content objects (see Figure 2 for the digital video recorder storing a first and second video stream), said control and acquisition storage set-top box comprising a media control module (see video data stream manager 230 in Figure 2) for accessing, for transmission on said network, at

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least one type of said digital data content object (see Figure 2 for transmitted a second video stream 223 over the recorded video signal transmission path 108).

Elliot also discloses playback set top box (see set top box 100 in Figure 1), coupled to said network (see Column 5, Lines 51-58), for receiving said digital data content object from said control and acquisition storage set top box (see Figure 2 for receiving a video stream over recorded video signal transmission path 108), said playback set top box comprising a decoder for decoding media comprised in said digital data content object (see MPEG decoder 122 in Figure 2).

Elliot also discloses a client device, coupled to said playback set top box (see client device 300 coupled to set top box 100 in Figure 2), for displaying output from a media application (see Column 4, Lines 37-40) and for playing media comprised in said digital data content object (see Column 3, Line 64 through Column 4, Line 2).

As stated above, although rejection under 112 1st paragraph, Iwamura fails to teach, "*running at least one of a plurality of media applications on a client device on said type of digital data content object*". Although the specification fails to teach this limitation, the examiner takes Official Notice that it is well known in the art for client device applications to be controlled by a master device in a home network, by the use of an API or any other type of software level interface for devices (for example Sony's HAVI home network systems) for interpreting a specific type of digital data object transmitted and received throughout the home media network.

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art, to modify the home network system components, as taught by

Elliot, to utilize the software interface on each component of the home media network for the purpose of providing an easy to use software interface to provide interoperability between multiple devices.

Referring to claim 102, see the rejection of claim 86.

Referring to claim 104, Elliot discloses a video application for playing digital data content objects that comprise digital video files (see Column 3, Line 64 through Column 4, Line 2).

Referring to claim 105, see the rejection of claim 104 and further note that the video signal being displayed further comprises accompanying audio.

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason P. Salce whose telephone number is (571) 272-7301. The examiner can normally be reached on M-F 9am-6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Miller can be reached on (571) 272-7353. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Jason P Salce
Primary Examiner
Art Unit 2623

April 11, 2007



JASON SALCE
PRIMARY PATENT EXAMINER